IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/045,149
Applicant	:	Edgar CIRCENIS, et al.
Filed	:	January 15, 2002
Title	:	SOFTWARE PAY-PER-USE PRICING
TC/A.U.	:	3639
Examiner	:	WU, RUTAO
Docket No.	:	10016873-1
Customer No.	:	022879

Mail Stop Appeal Brief - Patents
Commissioner of Patents
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CORRECTIVE APPEAL BRIEF UNDER 37 C.F.R. §41.37

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WAS:124416.1

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I.   REAL PARTY IN INTEREST

Hewlett Packard Company is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences.

III.   STATUS OF CLAIMS

Claims 33-65 are pending in the application. Claims 33-65 stand rejected. Applicants appeal the rejection of claims 33-65.

IV. STATUS OF AMENDMENTS

There were no amendments filed after final.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants have discovered a new, improved software pay-per-use (PPU) system, a new, improved computer implemented method for generating a bill for using a PPU software product, and a new, improved computer readable storage medium containing instructions for generating a bill for using a PPU software product. The prior art does not teach or suggest the new, improved PPU system, computer implemented method for generating a bill for using a PPU software product or computer readable storage medium containing instructions for generating a bill for using a PPU software product.

Appellants PPU system, *e.g.*, as claimed in independent claim 33 includes a first computer 18 having one or more PPU software products 30, a metrics gathering tool 25 associated with each of the one or more PPU software products, wherein each metrics gathering tool monitors and measures usage data for its associated one or more PPU software products, a software metering agent 20 residing on the first computer, wherein the software metering agent collects the measured usage data from each metrics gathering tool associated with the one or more PPU software products and collects usage data for all of the one or more PPU software products registered with the software metering agent on the first computer, a utility metering appliance 15 connected to a plurality of computers, including the first computer, through a network, wherein the utility metering appliance receives the collected usage data from the software metering agent residing on the first computer and other software metering agents residing on other computers connected to the utility metering appliance through the network, and a usage collection and billing system 40, wherein the usage collection and billing system periodically receives the collected usage data from the utility metering appliance and processes the collected usage data to generate billing information for PPU software products on the plurality of computers connected to the utility metering appliance through the network (see, *e.g.*, p. 1, para. [0012]-p. 3, para. [0025], FIGS. 1-2).

Appellants computer implemented method for generating a bill for using a PPU software product, *e.g.*, as claimed in independent claim 52, includes measuring 210 usage data associated with one or more PPU software products using a metrics gathering tool at a first computer having one or more PPU software products, wherein one metrics gathering tool is associated with each of the one or more PPU software products, collecting 220 the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products using a software metering agent, wherein the software metering agent collects usage data for all of the one or more PPU software products registered with the

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software metering agent on the first computer, receiving 230 the collected usage data from the software metering agent residing on the first computer and from a plurality of other software metering agents residing on a plurality of computers, wherein the collected usage data is collected at a utility metering appliance connected to the plurality of computers, including the first computer, through a network, processing 240 the collected usage data from each metrics gathering tool associated with each of the one or more PPU software products on the first computer received from the utility metering appliance, and generating 260 the bill for using the one or more PPU software products on the first computer based on the processed collected usage data from the first computer (see, *e.g.*, p. 3, para. [0026]- p. 4, para. [0032], FIG. 3).

Appellants computer readable storage medium containing instructions for generating a bill for using a PPU software product, *e.g.*, as claimed in independent claim 59, includes instructions for measuring 210 usage data associated with one or more PPU software products using a metrics gathering tool at a first computer having one or more PPU software products, wherein one metrics gathering tool is associated with each of the one or more PPU software products, collecting 220 the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products using a software metering agent, wherein the software metering agent collects usage data for all of the one or more PPU software products registered with the software metering agent on the first computer, receiving 230 the collected usage data from the software metering agent residing on the first computer and from a plurality of other software metering agents residing on a plurality of computers, wherein the collected usage data is collected at a utility metering appliance connected to the plurality of computers, including the first computer, through a network, processing 240 the collected usage data from each metrics gathering tool associated with each of the one or more PPU software products on the first computer received from the utility metering appliance, and generating 260 the bill for using the one or more PPU software products on the first computer based on the processed collected usage data from the first computer (see, *e.g.*, p. 3, para. [0026]- p. 4, para. [0032], FIG. 3).

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(1) Claims 33-46 and 48-65 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2002/0083003 to Halliday et al. (hereafter, *Halliday*) (See June 2, 2006 Office Action ("Final Office Action"), p. 5, para. 5); and

(2) Claim 47 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious over *Halliday* (See Final Office Action, p. 14, para. 7).

VII. ARGUMENT

The pending claims are patentable over the cited prior art. As noted above, the Final Office Action sets forth two grounds for rejection, one based on 35 U.S.C. § 102 and the other based on 35 U.S.C. § 103. Central to each of these grounds of rejection is the insufficient reference *Halliday*. The rejections set forth by the Examiner must fail because *Halliday* fails to describe, teach or suggest each and every limitation of the independent claims. Since the prior art reference cited fails to teach or suggest all of the claim limitations, the Final Office Action fails to establish a *prima facie* case of anticipation or obviousness and the claims must be allowed.

Rejection of Claims 33-46 and 48-65 Under 35 U.S.C. § 102(e) Must Fail Because Halliday Fails to Describe Each and Every Element of the Claims

Claims 33-46 and 48-65 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Halliday*. However, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 Fed. Cir. 1987). *Halliday* does not describe each and every element as set forth in claims 33-46 and 48-65.

A. Halliday Fails to Describe A Software Metering Agent - Halliday's Metering Monitor is Not the Software Metering Agent - Claims 33-46, 48-51

For example, *Halliday* does not inherently or explicitly describe:

> a software metering agent residing on the first computer, wherein the software metering agent collects the measured usage data from each metrics gathering tool associated with the one or more PPU software products and collects usage data for all of the one or more PPU software products registered with the software metering agent on the first computer,

as recited in independent claim 33.

The Examiner sought to meet this claim limitation by citing solely to paragraph [0056] of *Halliday* and the metering monitor discussed therein. Specifically, in responding to Applicants' remarks, the Examiner stated that the "metering monitor teaches 'a software metering agent'." In paragraph [0056] *Halliday* notes that the "specifically configured software packages" downloaded to a user's local computer includes, "in addition to the client application" and a "metering monitor." Paragraph [0056] also states that the "metering monitor may also act as a proxy server, accumulating metering information and forwarding the information as a batch to the central server at periodic intervals set by the server."

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Paragraph [0056] does not describe that the metering monitor "collects the measured usage data from each metrics gathering tool associated with the one or more PPU software products and collects usage data for all of the one or more PPU software products." (emphasis added). Indeed, as described in paragraph [0056], a metering monitor is included in each specially configured software package. Therefore, the metering monitor only accumulates metering information for the client application in the software package, not all of the PPU software products and not from each metrics gathering tool. Furthermore, it is also worth noting that *Halliday* does not describe any software products "registered" with the claimed software metering agent. Therefore, it cannot meet the feature of "PPU software products registered with the software metering agent on the first computer." (emphasis added). Consequently, *Halliday* does not inherently or explicitly describe the claimed software metering agent.

Since *Halliday* does not inherently or explicitly describe the claimed software metering agent, independent claim 33 is not anticipated and is allowable. Consequently, for these reasons and their own independent features, dependent claims 34-47 and 49-51 are also allowable.

B. **Halliday Fails to Describe Collecting the Measured Usage Data From Each Metrics Gathering Tool Using a Software Metering Agent - Claims 52-65**

Likewise, *Halliday* fails to inherently or explicitly describe

collecting the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products using a software metering agent, wherein the software metering agent collects usage data for all of the one or more PPU software products registered with the software metering agent on the first computer,

as recited in independent claims 52 and 59. As above with software metering agent in claim 33, the Examiner cites to the metering means described in paragraph [0056] of *Halliday* to attempt to anticipate this element. As above, the Examiner fails.

As shown above with regards to claim 33, there is no description in paragraph [0056] of the metering monitor "collecting the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products using a software metering agent, wherein the software metering agent collects usage data for all of the one or more PPU software products." (emphasis added) As noted above, a metering monitor is included in each specially configured software package. Furthermore, the metering monitor only

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accumulates metering information for the client application in the software package, not all of the PPU software products and not from each metrics gathering tool, as claimed. Furthermore, as noted above, *Halliday* does not meet the feature of "PPU software products registered with the software metering agent on the first computer." (emphasis added). Consequently, *Halliday* does not inherently or explicitly describe the claimed collecting.

Since *Halliday* does not inherently or explicitly describe the claimed collecting, independent claims 52 and 59 are not anticipated and is allowable. Consequently, for these reasons and their own independent features, dependent claims 53-58 and 60-65 are also allowable.

C. Halliday Fails to Describe a Metrics Gathering Tool Associated with Each of the PPU Software Product - Claims 33-46, 48-51

Moreover, *Halliday* does not inherently or explicitly describe

a metrics gathering tool associated with each of the one or more PPU software products, wherein each metrics gathering tool monitors and measures usage data for its associated one or more PPU software products,

as recited in claim 33.

Again, the Examiner sought to meet this claim limitation by citing solely to paragraph [0056] of *Halliday* and the application library. Specifically, in responding to Applicants' remarks, the Examiner stated that the "application library teaches 'a metrics gathering tool'." In paragraph [0056] *Halliday* notes that the "specifically configured software packages" downloaded to a user's local computer includes, "in addition to the client application, an application library having metering means."

Nothing in paragraph [0056] describes the application library or the metering means as being "associated with each of the one or more PPU software products." (emphasis added). Conversely, rather than describing this required feature, paragraph [0056] suggests that the application library is associated only with the one client application with which it is included in the specifically configured software packages. Since *Halliday* fails to describe this feature, it must fail to describe the claimed metrics gathering tool.

Since *Halliday* does not inherently or explicitly describe the claimed metrics gathering tool, independent claim 33 is not anticipated and is allowable. Consequently, for these reasons and their own independent features, dependent claims 34-47 and 49-51 are also allowable.

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D.   Halliday Fails to Describe Measuring Usage Data Using a Metrics Gathering Tool - Claims 52-65

Likewise, *Halliday* fails to inherently or explicitly describe

> measuring usage data associated with one or more PPU software products using a metrics gathering tool at a first computer having one or more PPU software products, wherein one metrics gathering tool is associated with each of the one or more PPU software products,

as claimed in claims 52 and 59. As above with software metering agent in claim 33, the Examiner cites to the metering means described in paragraph [0056] of *Halliday* to attempt to anticipate this element. As above, the Examiner fails.

Nothing in paragraph [0056] describes the application library or the metering means as being "one metrics gathering tool [] associated with each of the one or more PPU software products." (emphasis added). Conversely, rather than describing this required feature, paragraph [0056] suggests that the application library is associated only with the one client application with which it is included in the specifically configured software packages. Since *Halliday* fails to describe this feature, it must fail to describe the claimed metrics gathering tool.

Since *Halliday* does not inherently or explicitly describe the claimed measuring, claims 52 and 59 are not anticipated and are allowable. Consequently, for these reasons and their own independent features, dependent claims 53-58 and 60-65 are also allowable.
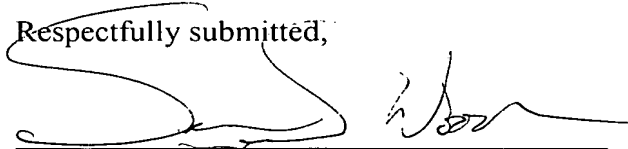
Rejection of Claim 47 Under 35 U.S.C. § 103(a) Must Fail Because Halliday Fails to Teach or Suggest Each and Every Element of the Claims

Claim 47 is rejected under 35 U.S.C. § 103(a) as being rendered obvious over *Halliday*. To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP § 2142. Claim 47 is allowable for the reasons provided above with regards to independent claim 33, on which claim 47 depends. *Halliday* does not teach or suggest each and every limitation of claim 33 and, hence, claim 47. It is also important to note that since *Halliday* does not describe a software metering agent, it cannot describe the claimed "utility metering appliance" or "receiving the collected usage data from the software metering agent." Likewise, even if the protocols recited in claim 47 are well known, as asserted by the Examiner, there is no suggestion or motivation provided by the Examiner for combining them with *Halliday*. In other words, just because something is well known does not mean there is a motivation to combine, which is

necessary for a *prima facie* obviousness rejection. Consequently, even if the Examiner overcame the defects in *Halliday* described above, the Examiner has failed to make a *prima facie* obviousness rejection of claim 47.

The appeal brief fee in the amount of **$500.00** has already been paid on October 10, 2006. However, should there be any additional fees required for this corrective appeal brief, please charge any fees required or credit any over payment to **Deposit Account 08-2025** pursuant to 37 CFR 1.25.

Respectfully submitted,

Date: **November 8, 2006**

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CLAIMS APPENDIX

Claims 1-32 (canceled).

Claim 33 (previously presented): A software pay-per-use (PPU) system comprising:

a first computer having one or more PPU software products;

a metrics gathering tool associated with each of the one or more PPU software products, wherein each metrics gathering tool monitors and measures usage data for its associated one or more PPU software products;

a software metering agent residing on the first computer, wherein the software metering agent collects the measured usage data from each metrics gathering tool associated with the one or more PPU software products and collects usage data for all of the one or more PPU software products registered with the software metering agent on the first computer;

a utility metering appliance connected to a plurality of computers, including the first computer, through a network, wherein the utility metering appliance receives the collected usage data from the software metering agent residing on the first computer and other software metering agents residing on other computers connected to the utility metering appliance through the network; and

a usage collection and billing system, wherein the usage collection and billing system periodically receives the collected usage data from the utility metering appliance and processes the collected usage data to generate billing information for PPU software products on the plurality of computers connected to the utility metering appliance through the network.

Claim 34 (previously presented): The system of claim 33, further comprising:

a registry for identifying all of the one or more PPU software products registered with the software metering agent on the first computer, wherein the registry includes identifiers for all of the one or more PPU software products registered with the software metering agent on the first computer and a pathname for each software metering agent associated with each of the one or more PPU software products.

Claim 35 (previously presented): The system of claim 33, wherein the software metering agent reads the pathname in the registry to access the associated metrics gathering tool and collect the measured usage data.

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Claim 36 (previously presented): The system of claim 33, wherein the software metering agent collects measured usage data from a plurality of metrics gathering tools.

Claim 37 (previously presented): The system of claim 33, wherein the utility metering appliance is located on a standalone computer on the network.

Claim 38 (previously presented): The system of claim 37, wherein the utility metering appliance is a software program residing on each of the plurality of computers.

Claim 39 (previously presented): The system of claim 33, wherein the metrics gathering tool is an executable script incorporated within the associated PPU software product.

Claim 40 (previously presented): The system of claim 33, wherein the software metering agent is periodically polled by the utility metering appliance.

Claim 41 (previously presented): The system of claim 33, wherein the usage collecting and billing system further comprises:

a billing computer, wherein the billing computer receives the collected usage data from the utility metering appliance and provides a bill to customers of the system based the generated billing information.

Claim 42 (previously presented): The system of claim 41, wherein the usage collecting and billing system provides a web portal, accessible by customers, that displays the billing information.

Claim 43 (previously presented): The system of claim 41, wherein the usage collecting and billing system provides a web portal, accessible by customers, that displays the collected usage data.

Claim 44 (previously presented): The system of claim 33, wherein the usage data includes cumulative usage data accumulated over a given time period or snapshot data.

Claim 45 (previously presented): The system of claim 33, wherein the usage data includes a number of input/output (I/O) transactions processed in a given time period.

Claim 46 (previously presented): The system of claim 33, wherein the usage data associated with the one or more of the PPU software products is based on one or more of the following: number of users of the system, number of users of a given type, software license level, number of transactions processed per minute, total number of transactions processed, number of files created, sizes of files created, number of keystrokes processed, number of times a specific software product feature has been accessed and number of computers on the system using one or more of the PPU software products.

Claim 47 (previously presented): The system of claim 33, wherein the software metering agent communicates to the utility metering appliance using one or more of a Simple Network Management Protocol, Web-Based Enterprise Management Protocol, Desktop Management Interface and Hypertext Transfer Protocol.

Claim 48 (previously presented): The system of claim 33, further comprising:

a second computer, from the plurality of computers, having one or more PPU software products;

a metrics gathering tool associated with each of the one or more PPU software products on the second computer, wherein each metrics gathering tool monitors and measures usage data for its associated one or more PPU software products on the second computer; and

a software metering agent residing on the second computer, wherein the software metering agent collects the measured usage data from each metrics gathering tool associated with the one or more PPU software products and collects usage data for all of the one or more PPU software products registered with the software metering agent on the second computer, and wherein the software metering agent residing on the second computer is connected to the utility metering appliance through the network and the utility metering appliance receives the collected usage data associated with the second computer from the software metering agent residing on the second computer.

Claim 49 (previously presented): The system of claim 48, the usage collection and billing system periodically receives the collected usage data associated with the second computer from the utility metering appliance and processes the collected usage data associated with the second computer to generate billing information for PPU software products on the second computer.

Claim 50 (previously presented): The system of claim 33, wherein the software metering agent collects measured usage data from a plurality of metric gathering tools in the first computer and transmits the collected usage data from the plurality of metric gathering tools to the utility metering appliance.

Claim 51 (previously presented): The system of claim 50, wherein the utility metering appliance receives the collected usage data from a plurality of software metering agents residing on the plurality of computers and transmits the collected usage data from the plurality of software metering agents to the usage collection and billing system.

Claim 52 (previously presented): A computer implemented method for generating a bill for using a pay-per-use (PPU) software product, the method comprising:

measuring usage data associated with one or more PPU software products using a metrics gathering tool at a first computer having one or more PPU software products, wherein one metrics gathering tool is associated with each of the one or more PPU software products;

collecting the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products using a software metering agent, wherein the software metering agent collects usage data for all of the one or more PPU software products registered with the software metering agent on the first computer;

receiving the collected usage data from the software metering agent residing on the first computer and from a plurality of other software metering agents residing on a plurality of computers, wherein the collected usage data is collected at a utility metering appliance connected to the plurality of computers, including the first computer, through a network;

processing the collected usage data from each metrics gathering tool associated with each of the one or more PPU software products on the first computer received from the utility metering appliance; and

generating the bill for using the one or more PPU software products on the first computer based on the processed collected usage data from the first computer.

Claim 53 (previously presented): The method of claim 52, further comprising:

identifying all of the one or more PPU software products registered with the software metering agent on the first computer by a registry, wherein the registry includes identifiers for all of the one or more PPU software products registered with the software metering agent

on the first computer and a pathname for each software metering agent associated with each of the one or more PPU software products.

Claim 54 (previously presented): The method of claim 53, further comprising:

reading the pathname in the registry to access the metrics gathering tool associated with the PPU software product; and

collecting the measured usage data associated with the PPU software product.

Claim 55 (previously presented): The method of claim 52, further comprising:

collecting the measured usage data from a plurality of metrics gathering tools.

Claim 56 (previously presented): The method of claim 52, further comprising:

periodically polling the software metering agent by the utility metering appliance to retrieve the measured usage data.

Claim 57 (previously presented): The method of claim 52, further comprising:

measuring usage data associated one or more PPU software products on a second computer using metrics gathering tools on the second computer, wherein a metrics gathering tool is associated with each of the one or more PPU software products; and

collecting the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products at a software metering agent on the second computer and from all of the one or more PPU software products registered with the software metering agent on the second computer, wherein the software metering agent residing on the second computer is connected to the utility metering appliance through the network and the utility metering appliance receives the collected usage data associated with the second computer from the software metering agent residing on the second computer.

Claim 58 (previously presented): The method of claim 57, further comprising:

processing the collected usage data from each metrics gathering tool associated with each of the one or more PPU software products on the second computer received from the utility metering appliance; and

generating the bill for using the one or more PPU software products on the second computer based on the processed collected usage data from the second computer.

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59. (previously presented): A computer readable storage medium containing instructions for generating a bill for using a pay-per-use (PPU) software product, by:

measuring usage data associated with one or more PPU software products using a metrics gathering tool at a first computer having one or more PPU software products, wherein one metrics gathering tool is associated with each of the one or more PPU software products;

collecting the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products using a software metering agent, wherein the software metering agent collects usage data for all of the one or more PPU software products registered with the software metering agent on the first computer;

receiving the collected usage data from the software metering agent residing on the first computer and from a plurality of other software metering agents residing on a plurality of computers, wherein the collected usage data is collected at a utility metering appliance connected to the plurality of computers, including the first computer, through a network;

processing the collected usage data from each metrics gathering tool associated with each of the one or more PPU software products on the first computer received from the utility metering appliance; and

generating the bill for using the one or more PPU software products on the first computer based on the processed collected usage data from the first computer.

Claim 60 (previously presented): The computer readable storage medium of claim 59, further comprising:

identifying all of the one or more PPU software products registered with the software metering agent on the first computer by a registry, wherein the registry includes identifiers for all of the one or more PPU software products registered with the software metering agent on the first computer and a pathname for each software metering agent associated with each of the one or more PPU software products.

Claim 61 (previously presented): The computer readable storage medium of claim 60, further comprising:

reading the pathname in the registry to access the metrics gathering tool associated with the PPU software product; and

collecting the measured usage data associated with the PPU software product.

Claim 62 (previously presented): The computer readable storage medium of claim 59, further comprising:

collecting the measured usage data from a plurality of metrics gathering tools.

Claim 63 (previously presented): The computer readable storage medium of claim 59, further comprising:

periodically polling the software metering agent by the utility metering appliance to retrieve the measured usage data.

Claim 64 (previously presented): The computer readable storage medium of claim 59, further comprising:

measuring usage data associated one or more PPU software products on a second computer using metrics gathering tools on the second computer, wherein a metrics gathering tool is associated with each of the one or more PPU software products; and

collecting the measured usage data from each metrics gathering tool associated with each of the one or more PPU software products at a software metering agent on the second computer and from all of the one or more PPU software products registered with the software metering agent on the second computer, wherein the software metering agent residing on the second computer is connected to the utility metering appliance through the network and the utility metering appliance receives the collected usage data associated with the second computer from the software metering agent residing on the second computer.

Claim 65 (previously presented): The computer readable storage medium of claim 64, further comprising:

processing the collected usage data from each metrics gathering tool associated with each of the one or more PPU software products on the second computer received from the utility metering appliance; and

generating the bill for using the one or more PPU software products on the second computer based on the processed collected usage data from the second computer.

EVIDENCE APPENDIX

No evidence submitted.

RELATED PROCEEDINGS APPENDIX

No related proceedings.